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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,361	07/18/2000	Ambikaipakan Balasubramaniam	UOC/136R	8955

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Wood Herron & Evans LLP  
2700 Carew Tower  
Cincinnati, OH 45202

EXAMINER

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 12/31/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/618,361

Applicant(s)

BALASUBRAMANIAM ET AL.

Examiner

Chih-Min Kam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-11, 16, 17 and 25-52 is/are pending in the application.
- 4a) Of the above claim(s) 3-11, 16, 17 and 25-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 3-11, 16-17, 25-52 are pending.

Applicants' amendment filed on October 17, 2002 (Paper No. 8) is acknowledged, and applicants' response has been fully considered. Claim 40 has been amended. Claims 3-11, 16, 17 and 25-39 are non-elected inventions and withdrawn from consideration. Thus, claims 40-52 are examined.

### ***Sequence Listing***

2. The CRF filed October 18, 2002 has error (see attached raw sequence listing error report, a copy of this report has been faxed to the applicant). Appropriate correction is required. Applicants must comply with the requirements of the sequence rules (37 CFR 1.81-1.825) and provide a copy of sequence listing and CRF containing all the sequences. The period for response is the same as for response to this Office Action set on the PTO-326.

### ***Abstract***

3. The amended abstract has been entered.

### **Objection Withdrawn**

4. The previous objection to claim 40 regarding position of the substituent ( $\alpha$  or  $\epsilon$ ), is withdrawn in view of applicants amendment of the claim, and applicants' response at page 4 in paper No. 8.

### **Rejection Withdrawn**

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***Claim Rejections - 35 USC § 112***

5. The previous rejection of claims 40-52, under 35 U.S.C.112, second paragraph, is withdrawn in view of applicants' amendment to the claim, and applicants' response at pages 4-5 in Paper No. 8.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 40-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 40-52 are indefinite because of the use of the term "each bond between two amino acids, or amino acid derivatives, represented by a dash ("-"), can be either a peptide bond or a pseudopeptide bond". The term "each bond between two amino acids, or amino acid derivatives, represented by a dash ("-"), can be either a peptide bond or a pseudopeptide bond" renders the claim indefinite, it is not clear how a bond between two amino acids can be a pseudopeptide such as CH<sub>2</sub>-NH, CH<sub>2</sub>-S, CH<sub>2</sub>CH<sub>2</sub>, CH<sub>2</sub>-CO and CH<sub>2</sub>-CH<sub>2</sub> since A1, A2 and A3 are defined as amino acids in claim 40. Claims 41-52 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 40 and 43 is rejected under 35 U.S.C. 102(b) as being anticipated by Koenig *et al.* (EP 288965 (November, 1988)).

Koenig *et al.* teach a peptide having formula of L-B-A, wherein N-terminal group can be benzyloxycarbonyl or (C<sub>1</sub>-C<sub>4</sub>)-alkylcarbonyl, L is lipophilic residue such as Leu and Trp, B is basic residue such as Orn and Cit, A is aromatic residue such as Trp, and C-terminal carboxyl group is protected as an ester or amide, is useful as Phospholipase A2 inhibitor (page 2, lines 13-53; claims 40 and 43).

In response, applicants indicate claim 40 has been amended to remove Lys residue, thus, the claim is not anticipated by Koenig *et al.* (page 5 of the response). The argument is not found persuasive because the reference teaches a compound of L-B-A, where L is Leu or Trp, B is Orn or Cit, and A is Trp, which meet the criteria for the claimed compound as indicated above.

A copy of English translation of Koenig *et al.* will be sent to applicants once the examiner receives it.

### ***Conclusion***

8. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*  
Patent Examiner

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December 23, 2002

*Christopher S. Low*  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
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